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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,958	10/22/2001	David Kalman Biegelsen	XXT-122	8564
7590 04/20/2004			EXAMINER	
Patrick R. Roche FAY, SHARPE, FAGAN, MINNICH & McKEE 1100 Superior Avenue, 7th Floor Cleveland, OH 44114-2579			GRAY, LINDA LAMEY	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/033,958

Applicant(s)

BIEGELSEN ET AL.

Examiner

Linda L Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-31 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 21-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**Detailed Action**

**Claim Rejections - 35 USC § 102**

**1.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**2. Claims 1-3, 6-11, and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Macken (US 4,458,133).**

Claim 1, Macken teaches a method of cutting member 16 including adhering member 16 to template 18 and projecting cutting element 24 through template 18 without intersecting with template 18 to cut member 16 (c 3, L 27, to c 6, L 66).

Claim 2, element 24 is a laser.

Claim 3, member 16 is a multi-layered film.

Claim 6, the method includes providing template 18 having predefined cutout sections 20 for accommodating the cutting of member 16 by laser 24.

Claim 7, adhering includes removably attaching template 18 to a surface of member 16 through one of compression and contact via magnetic fields exerted on template 18 by magnets 12 under member 16 such that template 18 is considered to have low tack properties with magnets 12 though member 16 is therebetween.

Claim 8, contact electrostatic holding removably adheres member 17 to template 24 via electromagnetic forces.

Claim 9, projecting includes directing element 24 to pass through template 18 without cutting template 18 to cut through member 16 in a pattern corresponding to template 18.

Claim 10, member 16 is removed from under 18 for use after cutting such that cut member 16 (i.e., member formation) is transferred to a separate location.

Claim 11, template 18 is removed from member 16 and is re-usable.

Claim 21, Macken teaches an assemblage produced by sandwiching member 16 between base 10 and template 18. The assemblage includes member 16 and template

18 removably adhered to member 16. Template 18 is suitable for accommodating laser 24 to cut member 16. The limitation of projecting a laser through the template without intersecting the template to cut the member to form one or more member formations is an intended use of the claimed assemblage and does not provide a structural difference to the claim.

Claim 22, member 16 is a multi-layer film.

**3. Claims 1-2, 6, 9-11, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Provancher (US 4,262,186).**

Claim 1, Provancher teaches a method of cutting member 10 including adhering member 10 to template 14 and projecting cutting element 18 through template 14 without intersecting with template 14 to cut member 10 (c 2-3).

Claim 2, the element 18 is a laser.

Claim 6, the method includes providing template 14 having predefined cutout sections 16 for accommodating the cutting of member 10 by laser 18.

Claim 9, projecting includes directing element 18 to pass through template 14 without cutting template 14 to cut through member 10 in a pattern corresponding to template 140.

Claim 10, member 10 is removed from under template 14 for use after cutting such that cut member 10 (i.e., member formation) is transferred to a separate location.

Claim 11, template 14 is removed from member 10 and is re-usable.

Claim 21, Provancher teaches an assemblage produced by sandwiching member 10 between base 14 and template 14. The assemblage includes member 10 and template 14 removably adhered to member 10. Template 14 is suitable for accommodating laser 18 to cut member 10. The limitation of projecting a laser through the template without intersecting the template to cut the member to form one or more member formations is an intended use of the claimed assemblage and does not provide a structural difference to the claim.

**Claim Rejections - 35 USC § 103**

**4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macken.**

Claims 4 and 5, Macken teaches using the apparatus to cut "numerous types of sheet materials, of different thicknesses, and densities, with certain parameters being adjusted to accommodate the material used." (c 3, L 17-20). Paper, cloth, and the like are examples (c 1, para 1) though the reference is not closed to only these types of materials. Further, laser cutting members comprising metal and polymer layers, such as aluminum and polyester, is conventional in various arts such as members used in the microelectromechanical and/or microelectronic industry, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Macken using the apparatus to cut other materials such as those conventionally laser cutting art.

**Response to Comments**

**5. Applicants' comments filed 1-16-04 have been fully considered.**

The rejection of claim 22 under 35 U.S.C. 112, second paragraph is withdrawn in that both claims 21 and 22 are product claims.

For claim 1, Contrary to Applicants' comment, Macken teaches cutting at column 3, lines 27-34.

The rejection over Beresford with withdrawn in that Beresford does not teach adhering as required in claim 1.

Applicants indicate that the pending claims do not require a maskant coating on both sides of the member 10 to be cut. In response, the pending claims include "comprising" claim language and not "consisting of" claim language.

Contrary to Applicants' comments, claim 21 does not require a polymeric base for support when only one template 16 is in use (see pg 7 of response, lines 10-11).

Applicants indicate that Provancher does not teach a method of transferring member formation to separate locations. In response, member 10 is removed from under template 14 for use after cutting such that cut member 10 (i.e., member formation) is transferred to a separate location.

**Allowable Subject Matter**

**6. Claims 23-31 are allowable.**

**7.** The following is a statement of reasons for the indication of allowable subject matter: **claim 23**, the prior art of record does not teach adhering the member to a low-tack surface wherein during the step of removing the template from the member, portions of the member are adhered to the template where such are discarded from the template.

**8.** As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

**Conclusion**

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**10.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached at (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

**Art Unit: 1734**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg

April 15, 2004

*Linda D. Gray*  
LINDA GRAY  
PRIMARY EXAMINER